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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,038	06/13/2000	Yasutaka Urakawa	030675-043	5615

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

GA

Office Action Summary

Application No.

09/593,038

Applicant(s)

URAKAWA, YASUTAKA

Examiner

Erika A. Gary

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9, 11-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-31 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15, 17-21, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
2a. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. It appears the above mentioned reference number should be disclosed in the specification on page 32.

Claim Objections

2. Claim 26 is objected to because of the following informalities: it appears claim 26 should be dependent upon claim 25 and not claim 29. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11-15, 17-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomiyori, US Patent Number 5,305,372 (hereinafter Tomiyori) in view of Applicant's submission of prior art, Sanpei et al., US Patent Number 5,732,349 (hereinafter Sanpei).

Regarding claim 1, Tomiyori discloses a portable communication device for communication via a connected telephone circuit, comprising: communication destination party information memory means for storing communication destination party information including communication destination party identifying information of a communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; input/output means for displaying, in response to a user's operation, a list of the communication destination party identifying information stored in the communication destination party information memory means; calling processing means for dialing a call to a communication destination party selected from the list of the communication destination party identifying information displayed by the input/output means; and using country information recognizing means for recognizing a country where the portable communication device is connected to the telephone circuit; wherein the calling processing means automatically converts, upon necessary, the subscriber number information stored in the communication destination party information memory means into a subscriber number suitable for a domestic or international call based on a result of comparison between the using country information recognized by the using country

information recognizing means and the country identifying information of the communication destination party selected as a call destination, and dials a resultant subscriber number [fig. 1; col. 1: line 44 – col. 2: line 9].

What Tomiyori does not specifically disclose is that the country information recognizing means automatically recognizes the country where the portable communication device is connected to the telephone circuit without a user input command. However, Sanpei teaches this limitation.

Sanpei discloses a system and method for controlling a portable communication device according to a discriminated area code wherein the country in which the device is located is recognized automatically without a user input command [col. 6: lines 9-12].

Tomiyori and Sanpei are combinable because they are from the same field of endeavor, that is, operating a portable communication device based on its location. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori to include Sanpei. The motivation for this modification, as suggested by Tomiyori, would have been to provide greater ease of use and convenience to the user by making dialing features more automatic by requiring less user intervention [col. 1: lines 30-43].

Regarding claim 2, Tomiyori discloses the subscriber number information includes a subscriber number for a domestic call from a country where the communication destination party is a subscriber of the telephone service to the communication destination party in the country, and the calling processing means automatically converts the subscriber number of the communication destination party,

registered in the communication destination party information memory means, into a subscriber number suitable for an international call when the comparison between the using country information and the country identifying information results that they do not coincide with each other, and dials the resultant subscriber number, the subscriber number suitable for an international call including a country code of a country specified by the country identifying information of the communication destination party [fig. 1; col. 1: line 44 – col. 2: line 9].

Regarding claim 3, Tomiyori discloses the subscriber number information includes information, at least a country code, which enables an international call from outside a country where the communication destination party is a subscriber of the telephone service to the communication destination party in the country; and the calling processing means automatically converts the subscriber number of the communication destination party, registered in the communication destination party information memory means, into a subscriber number suitable for a domestic call to the communication destination party by deleting at least the country code therefrom when the comparison between the using country information and the country identifying information results that they coincide with each other, and dials the resultant subscriber number [col. 4: lines 36-39].

Regarding claim 4, Tomiyori discloses a portable communication device for communication via a connected telephone circuit, comprising: communication destination party information memory means for storing communication destination party information including communication destination party identifying information of a

communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; input/output means for displaying, in response to a user's operation, a list of the communication destination party identifying information stored in the communication destination party information memory means; calling processing means for dialing a call to a communication destination party selected from the list of the communication destination party identifying information displayed by the input/output means; and using country information recognizing means for recognizing a country where the portable communication device is connected to the telephone circuit; wherein when making a call, the calling processing means is able to change a selected subscriber number information, based on judgment that the subscriber number information of the communication destination party, stored in the communication destination party information memory means, is not usable for dialing a call, the judgment being based on comparison between the using country information recognized by the using country information recognizing means and the country identifying information of the communication destination party selected as a called party [fig. 1; col. 1: line 44 – col. 2: line 9].

What Tomiyori does not specifically disclose is that the country information recognizing means automatically recognizes the country where the portable communication device is connected to the telephone circuit without a user input command. However, Sanpei teaches this limitation.

Sanpei discloses a system and method for controlling a portable communication device according to a discriminated area code wherein the country in which the device is located is recognized automatically without a user input command [col. 6: lines 9-12].

Tomiyori and Sanpei are combinable because they are from the same field of endeavor, that is, operating a portable communication device based on its location. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori to include Sanpei. The motivation for this modification, as suggested by Tomiyori, would have been to provide greater ease of use and convenience to the user by making dialing features more automatic by requiring less user intervention [col. 1: lines 30-43].

Regarding claim 5, Tomiyori discloses the calling processing means automatically places the selected subscriber number information in an edit mode when the using country information does not coincide with the country identifying information [col. 1: line 67 – col. 2: line 4].

Regarding claim 6, Tomiyori discloses a temporary number memory means for temporarily storing a temporary number and using country information when the calling processing means calls the communication destination party selected, by dialing the temporary number, the temporary number being formed by editing the subscriber number information, wherein the calling processing means calls the communication destination party by dialing the temporary number temporarily stored, when the using country information recognized by the using country information recognizing means coincides

with the using country information of the communication destination party stored in the temporary number memory means [col. 2: lines 61-63; col. 4: lines 8-24].

Regarding claim 7, Tomiyori discloses information of the communication destination party, stored in the temporary number memory means, is erased when the using country information recognized by the using country information recognizing means does not coincide with the using country information of the communication destination party, stored in the temporary number memory means [col. 2: lines 61-63; col. 4: lines 25-36].

Regarding claim 8, Tomiyori discloses a portable communication device for communication with a communication destination party via a base station through a connected telephone circuit, comprising: communication destination party information memory means for storing communication destination party information including communication destination party identifying information of a communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; input/output means for displaying, in response to a user's operation, a list of the communication destination party identifying information stored in the communication destination party information memory means; and using country information recognizing means for obtaining, from information sent from the base station, using country information of a country where the portable communication device is connected to the telephone circuit; calling processing means for specifying a subscriber number when a call is made to communication

destination party selected as a called party from a list of communication destination party identifying information displayed by the input/output means, based on a comparison between the using country information recognized by the using country information recognizing means and the country identifying information of the communication destination party selected as a called party [fig. 1; col. 1: line 44 – col. 2: line 9].

What Tomiyori does not specifically disclose is that the country information recognizing means obtains from information sent from a base station, the country where the portable communication device is connected to the telephone circuit. However, Sanpei teaches this limitation.

Sanpei discloses a system and method for controlling a portable communication device according to a discriminated area code wherein the country in which the device is located is recognized from information sent from a base station [col. 6: lines 9-12].

Tomiyori and Sanpei are combinable because they are from the same field of endeavor, that is, operating a portable communication device based on its location. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori to include Sanpei. The motivation for this modification, as suggested by Tomiyori, would have been to provide greater ease of use and convenience to the user by making dialing features more automatic by requiring less user intervention [col. 1: lines 30-43].

Regarding claim 9, Tomiyori discloses the communication destination party information memory means stores, in place of the communication destination party

information, at least one information, including a pair, for every communication destination party, constituting of using country information and subscriber number information to be referred to when making a call from the using country to the communication destination party, and the calling processing means places a call based on subscriber number information designated in communication destination party information including using country information coincident with using country information recognized by the using country information recognizing means [fig. 1: ref. 11].

Regarding claim 10, Tomiyori discloses a portable communication device for communication with a communication destination party via a base station through a connected telephone circuit, comprising: communication destination party information memory means for storing communication destination party information including communication destination party identifying information of a communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; input/output means for displaying, in response to a user's operation, a list of the communication destination party identifying information stored in the communication destination party information memory means; and calling processing means for dialing a call to a communication destination party selected from the list of the communication destination party identifying information displayed by the input/output means; wherein the calling processing means adds country identifying information of the communication destination party selected as a called party to the subscriber number information of the selected communication

destination party and sends to the base station when making a call [fig. 1; col. 1: line 44 – col. 2: line 9].

Regarding claim 12, it is inherent in the art to carry out radio communication using a circuit fixedly connected to circuits of the country to which the circuit was initially connected at a time of making a call.

Regarding claim 13, Tomiyori discloses a communication module for connecting to a telephone circuit; and a communication device main body for communication via the communication module; wherein the communication module comprises an antenna, transmitter/receiver means for transmitting and receiving a message via the antenna, and radio communication control means for controlling radio communication according to a predetermined communication format [col. 2: lines 39-51].

Regarding claim 14, Tomiyori discloses the portable communication device is in the form of a portable telephone device [col. 2: lines 39-41].

Regarding claim 15, the Examiner takes Official Notice that it is well known in the art to provide detachable communication modes. At the time of the invention, it would have been obvious to modify Tomiyori and Sanpei to include this feature as the physical structure of portable communication devices are a matter of design choice.

Regarding claim 17, Tomiyori discloses a communication module for connecting to a telephone circuit; and a communication device main body for communication via the communication module; wherein the communication module has using country information replying means for replying using country information in response to an

inquiry from the processing means [col. 2: lines 39-51, 57-60; fig. 1: ref. 10; col. 4: lines 15-18].

Regarding claim 18, Tomiyori discloses communication destination party information registration means for generating communication destination party information based on information concerning a communication destination party input via the input/output means, a subscriber number of the communication destination party, and a country where the communication destination party is a subscriber of the telephone service, and for registering the communication destination party information to the communication destination party memory means [fig. 1: ref. 11; col. 3: lines 23-41].

Regarding claim 19, Tomiyori discloses the communication destination party information memory means has a country registration area provided thereto in advance for every country identifying information so that communication destination party identifying information and a subscriber number are stored in the country registration area of a corresponding country [fig. 1: ref. 11; col. 3: lines 23-41].

Regarding claims 11, 20 and 21, the Examiner takes Official Notice that it is well known in the art to provide detachable memory means, such as a SIM card. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori and Sanpei to include this limitation to provide a convenient means for transferring the memory information to another device.

Regarding claim 23, Tomiyori discloses an automatic calling method employed in a portable communication device for communication via a connected telephone circuit,

comprising: a communication destination party candidate displaying step of extracting communication destination party identifying information from communication destination party information memory means and displaying a list thereof, said memory means stores the communication destination party information including communication destination party identifying information of a communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; a comparison step of comparing country identifying information corresponding to a communication destination party selected from the list of communication destination party identifying information displayed at the communication destination party candidate displaying step, and using country information specifying a country where the portable communication device is connected to the telephone circuit; and a calling step of automatically converting, upon necessity, the subscriber number information of the communication destination party selected, into a subscriber number suitable for a domestic or international call based on a result of comparison made at the comparison step, and making a call [fig. 1; col. 1: line 44 – col. 2: line 9].

What Tomiyori does not specifically disclose is that the country information recognizing means automatically recognizes the country where the portable communication device is connected to the telephone circuit without a user input command. However, Sanpei teaches this limitation.

Sanpei discloses a system and method for controlling a portable communication device according to a discriminated area code wherein the country in which the device is located is recognized automatically without a user input command [col. 6: lines 9-12].

Tomiyori and Sanpei are combinable because they are from the same field of endeavor, that is, operating a portable communication device based on its location. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori to include Sanpei. The motivation for this modification, as suggested by Tomiyori, would have been to provide greater ease of use and convenience to the user by making dialing features more automatic by requiring less user intervention [col. 1: lines 30-43].

Regarding claim 24, Tomiyori discloses an automatic calling method employed in a portable communication device for communication via a connected telephone circuit, comprising: a communication destination party candidate displaying step of extracting communication destination party identifying information from communication destination party information memory means and displaying a list thereof, said memory means stores the communication destination party information including communication destination party identifying information of a communication destination party, subscriber number information of the communication destination party, and country identifying information for identifying a country where the communication destination party is a subscriber of telephone service; a comparison step of comparing country identifying information corresponding to a communication destination party selected from the list of communication destination party identifying information displayed at the

Art Unit: 2681

communication destination party candidate displaying step, and using country information specifying a country where the portable communication device is connected to the telephone circuit; and a calling step of displaying, for editing, the subscriber number information when a judgment is made based on a result of comparison made at the comparison step, that the subscriber number information of the communication destination party, stored in the communication destination party information memory means, is no usable intact for dialing a call, and making a call using a resultant subscriber number edited [fig. 1; col. 1: line 44 – col. 2: line 9].

What Tomiyori does not specifically disclose is that the country information recognizing means automatically recognizes the country where the portable communication device is connected to the telephone circuit without a user input command. However, Sanpei teaches this limitation.

Sanpei discloses a system and method for controlling a portable communication device according to a discriminated area code wherein the country in which the device is located is recognized automatically without a user input command [col. 6: lines 9-12].

Tomiyori and Sanpei are combinable because they are from the same field of endeavor, that is, operating a portable communication device based on its location. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Tomiyori to include Sanpei. The motivation for this modification, as suggested by Tomiyori, would have been to provide greater ease of use and convenience to the user by making dialing features more automatic by requiring less user intervention [col. 1: lines 30-43].

Allowable Subject Matter

5. Claims 25-31 are allowed.

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments, see page 9, filed June 11, 2003, with respect to the rejection(s) of claim(s) 8 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tomiyori in view of Sanpei.

Applicant's arguments with respect to claims 1, 4, 23, and 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh N. Tran can be reached on 703-305-4040. The fax phone numbers for

Art Unit: 2681

the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, VA., Sixth Floor (Receptionist).

EAG
August 31, 2003


ERIKA GAHY
PATENT EXAMINER